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09/709,900	11/10/2000	John J. Gabrick	MINMAT.P01	3638

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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT PAPER NUMBER

3621

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/709,900

Applicant(s)

GABRICK ET AL.

Examiner

Mary Cheung

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of the Application***

1. This action is in response to the amendment filed on December 3, 2003. Claims 1-19 are pending. Claim 2 has been amended. Claim 19 has been added.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 19, the phrase "and the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "and the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 2 and 8-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Ziff et al., U. S. Patent 6,557,013.

As to claim 2, Ziff teaches a system for streamlining the process of creating, preserving and protecting proprietary assets, wherein the system identifies, classifies, compiles, tracks and routes real-time data automatically on a continuous basis, and provides instant access to stored database information, further wherein an employee has instant access to her latest innovations and proprietary materials, and constant supervision over them (abstract and column 5 lines 44-51 and column 6 lines 13-28 and column 7 lines 13-31, 53-65 and column 10 lines 18-51 and Fig. 1).

As to claim 8, Ziff teaches a system for web based development and exploitation IP, the system comprising (Fig. 1):

- a) An innovator attraction module is taught by Ziff as submission module that an innovator is able to submit his or her work (Fig. 2B);
- b) A developer attraction module is taught by Ziff as a developer module that writers and editors are able to inspect the work submitted by the innovator (Figs. 5A, 6A, 7A, 8A, 9A, 10A);
- c) A registration module is taught by Ziff as a module that the innovator registers his or her information (Figs. 2A-2C);
- d) A match module (Figs. 11A-11B);

Whereby the registration module is adapted to accept and stored dated related to an innovator and the innovator's innovation in an innovation database (column 6 lines 48-64 and column 7 lines 13-19), and further whereby the match module is adapted to

match a registration innovation and innovator with a developer having stated requirements and resource for development (Figs. 11A-11B).

As to claim 9, Ziff teaches the database is operably stored for random retrieval on a storage medium (column 6 lines 29-44 and Fig. 1).

As to claim 10, Ziff teaches updating and changing to innovation related data are also stored in the innovation database (column 10 lines 18-21).

As to claim 11, Ziff teaches the match module is adapted to match one or more innovations with one or more developers (Figs. 11A-11B).

As to claims 12-18, Ziff teaches a tracking module, whereby any status or outcome of any matching activity related to the innovation is made available to a user (column 6 lines 13-18 and column 10 lines 18-21 and Figs. 1, 11A-11B).

As to claim 19, Ziff teaches the stored database information is selected from user information and the like (column 7 lines 53-65).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under

37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1, 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asplen, Jr., U. S. Patent 6,044,354.

As to claim 1, Asplen teaches a system for automatically summarizing companying innovations, the system using intelligent agents to automatically perform searches to find competing or encroaching ideas, the system generating reports which list potential competitive strengths or weaknesses (column 3 lines 10-27 and Figs. 1-5).

Asplen does not specifically state that the searches are performed on the Internet. However, Asplen implements the Internet in the system (column 2 lines 9-14). It would have been obvious to one of ordinary skill in the art to allow the searches of Asplen to be performed on the Internet because it would allow to user to quickly and easily submit or obtain or evaluate information.

As to claim 4, Asplen teaches using predetermined criteria to measure and determine the innovations entered by employees into the system (column 3 lines 10-27). Asplen does not specifically state that the predetermined criteria comprise employee performance, overall corporate innovation levels, and qualified and motivated employees. However, it would have been obvious to one of ordinary skill in the art to realize these specific criteria are design choice, and it would have been an obvious matter of design choice to modify the teachings of Asplen to provide these specific

criteria as claimed. Since the applicant has not disclosed that these specific criteria solve any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Asplen will perform the invention as claimed by the applicant with any means, method, or product to these specific criteria.

As to claim 6, Asplen teaches employee enter their intellectual creations and receive an immediate, time/date certification therefor (column 2 lines 60-64 and Figs. 1A-2).

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Asplen, Jr., U. S. Patent 6,044,354 in view of Anand et al., U. S. Patent 5,721,903.

As to claim 3, Asplen teaches to determine and report some or all of the ideas that an individual has submitted according to predetermined criteria (column 3 lines 10-27). Asplen does not specifically teach using a query engine to determine and report some or all of the ideas that an individual has submitted over a selected time period. However, Anand teaches using query engine to generate reports according to selected time period (Fig. 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the system of Asplen to include a query engine for generating report according to selected time period because it would allow user to generate a specific report for better determining the best innovation for the business.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Asplen, Jr., U. S. Patent 6,044,354 in view of Suh, U. S. Patent 6,330,545.

As to claim 5, Asplen teaches using predetermined criteria to measure and determine the innovations entered by employees into the system (column 3 lines 10-27), and generating company Financial/Budget summary report (Figs. 4-5). Asplen does not specifically teach generating the company balance sheet comprising calculating employee's spending for the innovation. However, Suh teaches generating balance sheet including calculation of all the activity costs (column 7 lines 4-25 and Fig. 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the system of Asplen to include the step of calculating the expenses related to the innovation because it would allow the system to generate more accurate company balance sheet.

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Asplen, Jr., U. S. Patent 6,044,354 in view of Ziff et al., U. S. Patent 6,557,013.

As to claim 7, Asplen teaches the employee can link more details on each submission, and the system comprises the Internet and email capability (column 2 lines 9-14 and Figs. 1-5). Asplen does not specifically teach other users can email comments and suggestions directly to the author, or option submit their own improvements as a new or supplemental innovation. However, Ziff teaches other users use email information directly to the author (column 8 lines 54-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the system of Asplen to include the feature of allow other users to email the author information (i.e. comments or suggestions) for a better innovation.



***Response to Arguments***

12. Applicant's arguments filed December 3, 2003 have been fully considered but they are not persuasive.

Applicant argues that the filing date of Ziff (U. S. Patent 6,557,013) is March 15, 2000, that is several months after the effective priority date November 5, 1999 of the present application. However, Ziff claims benefit of prior application 60/125,982 filed on March 24, 1999. Thus, claims 2 and 8-19 are properly rejected under 35 U.S.C. 102(e).

In response to applicant's arguments that Asplen (U. S. Patent 6,044,354) does not teach the limitations of claims 1 and 3-7, Examiner respectfully disagrees because Asplen teaches these limitations in particular at column 3 lines 1-27. Asplen teaches evaluating new ideas and generating the results of the evaluation of the new ideas, that are correspond to the claimed limitation "a system for automatically summarizing company innovations"; Asplen further teaches after receiving the new ideas, evaluate the new ideas by analyzing how the ideas relate to the organization's strategies, whether they are competitive, use the evaluator to calculate the scores of the ideas, and generate customized results of the evaluations, that are correspond to the claimed limitations "the system using intelligent agents to automatically perform searches to find competing or encroaching ideas, the system generating reports which list potential competitive strengths or weaknesses". Asplen does not specifically state that the searches are performed on the Internet. As discussed in the previous office action the present office, Asplen implements the Internet in the system (column 2 lines 9-14). The motivation of allowing the searches to be performed on the Internet has been discussed

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in the previous office action the present office. Thus, the applicant's arguments are reversed.

***Conclusion***

**13. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 305-7687      (Official Communications; including After Final  
Communications labeled "BOX AF")  
(703) 746-5619      (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7<sup>th</sup> Floor Receptionist.

Mary Cheung  
Patent Examiner  
Art Unit 3621  
February 20, 2004



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